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	TORNEY DOCKET NO.	ATTORNEY DOCKET NO	FIRST NAMED APPLICA		FILING DATE	AL NUMBER
08/801,795 02/14/97 GUGLIELMI G	M203E-D-	G M203E-I	GUGLIELMI	2/14/97	795 02	08/80:

33M1/1219

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EXAM	INER			
COHEN, L				
ART UNIT	PAPER NUMBER			
3311				

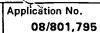
DATE MAILED:

12/19/97

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents





Applicant(s)

Examiner

Office Action Summary

Group Art Unit

Lee S. Cohen

3311

Guglielmi et al



Responsive to communication(s) filed on			
☐ This action is FINAL .			
☐ Since this application is in condition for allowance except for formal matter in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 45			
A shortened statutory period for response to this action is set to expire is longer, from the mailing date of this communication. Failure to respond w application to become abandoned. (35 U.S.C. § 133). Extensions of time in 37 CFR 1.136(a).	vithin the period for response will cause the		
Disposition of Claims			
	is/are pending in the application.		
Of the above, claim(s)	is/are withdrawn from consideration.		
☐ Claim(s)	is/are allowed.		
	is/are rejected.		
☐ Claim(s)	is/are objected to.		
☐ Claims are subject to restriction or election requirement.			
Application Papers			
	ГО-948.		
☐ The drawing(s) filed on is/are objected to by the	Examiner.		
☐ The proposed drawing correction, filed on is ☐	approved Edisapproved.		
\square The specification is objected to by the Examiner.			
☐ The oath or declaration is objected to by the Examiner.			
Priority under 35 U.S.C. § 119			
☐ Acknowledgement is made of a claim for foreign priority under 35 U.S			
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority	documents have been		
☐ received.			
 □ received in Application No. (Series Code/Serial Number) □ received in this national stage application from the International 			
*Certified copies not received:	Duleau (r C1 nule 17.2(a)).		
☐ Acknowledgement is made of a claim for domestic priority under 35 t	U.S.C. § 119(e).		
Attachment(s)			
Notice of References Cited, PTO-892	J		
☑ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5,6	·		
☐ Interview Summary, PTO-413			
Notice of Draftsperson's Patent Drawing Review, PTO-948			
☐ Notice of Informal Patent Application, PTO-152			
SEE OFFICE ACTION ON THE FOLLOWI	ING PAGES		

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Claims 32-34, 40-43, 45, 46, and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 32 - "said distal portion" in line 5 lacks antecedent basis. Claim 40 - "said steps of disposing a wire" lacks antecedent basis. Claim 41 sets forth a method of using a catheter in the preamble buts fails to recite a catheter in the body of the claim. Also, in claim 41, the detaching step should relate back to the previously recited tip portion. Claim 42 should reference the previously recited helix. Claim 45 - "said stainless steel segment" lacks antecedent basis. Claim 46 - "said coil" lacks antecedent basis. Claim 48 - "has a length and sufficient" is vague.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 25-48 are rejected under the judicially created doctrine of double patenting over claims 1-23 of U. S. Patent No. 5,122,136 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: apparatus and method for forming an occlusion.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(f) he did not himself invent the subject matter sought to be patented.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 33 and 43 are rejected under 35 U.S.C. 102(f)/103(a) as being unpatentable over the disclosed invention of Guglielmi. It would have been obvious design expedient to the skilled artisan to modify the shape of the helix given the teaching of Guglielmi absent evidence to the contrary. Claims 32 and 41 have not been included in this rejection since they would have necessarily been the invention of Guglielmi per se.

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It is noted that this application claims subject matter disclosed in prior copending applications. A reference to the prior applications must be inserted as the first sentence of the specification of this application if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). Also, the current status of all non-provisional parent applications referenced should be included.

Any inquiry concerning this communication should be directed to Lee S. Cohen at telephone number (703) 308-2998.

LEE S. COHEN PRIMARY EXAMINER GROUP 3300